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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,171	04/12/2001	Seth I. Merrin	22172-05507	2698

530 7590 12/16/2002

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EXAMINER

KYLE, CHARLES R

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 12/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/834,171

Applicant(s)

MERRIN ET AL.

Examiner

Charles R Kyle

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: The specification contains bracketed paragraph numbers. These should be removed.

Appropriate correction is required.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the mailing or post office address of each inventor. A mailing or post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing or post office address should include the ZIP Code designation. The mailing or post office address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2, 4, 5, 7, 8-15, and 23-37 are rejected under 35 U.S.C. 102(e) as being anticipated by *Korhammer et al.*

As to Claim 1, *Korhammer* discloses the invention as claimed, including in a system for performing electronic securities trading, the elements of:

An electronic trading marketplace for receiving orders for securities and for facilitating the trading of the securities (Fig. 2, ele. 16);

An interfacing module (Fig. 2, ele. 100) interfacing with an order management system database (inherent to Fig. 2, ele. 101), and in communication with the ETM for reading data records in the OMS database reflecting orders for securities (Order Book, Fig. 2, ele. 15) automatically (Col. 8, lines 39-46; Fig. 7, ele. 402) providing information indicating the orders for securities to the ETM (arrows between ele. 100 and 16 at least).

Regarding an order management system database, note that by definition a database is a collection of data stored on a computer storage medium, such as a disk, that can be used for more than one purpose. If data records reflecting orders for securities were not read and written on the database storage of Fig. 2, ele. 101, the trader would be precluded from executing trades. The same reasoning holds for other databases recited in the Claims..

With respect to Claim 2, *Korhammer* discloses sending trade information from the ETM to the OMS at Fig. 7, ele. 41. Use of a database for trading information would be inherent. The use trading databases in securities trading was old and well known to organize and provide access to information on a timely basis.

With respect to Claim 4, *Korhammer* discloses anonymous negotiation for trades at Col. 2, lines 51-53.

With respect to Claim 5, *Korhammer* discloses authentication of traders to trade at Col. 6, Lines 57-63.

Regarding Claim 7, *Korhammer* discloses format conversion between OMS and ETM at Fig. 3, arrows connecting elements 201 and 51 at least and Col. 7, lines 21-34.

As to Claim 8, *Korhammer* discloses filtering of orders at Fig. 3, ele. 205 and Col. 7, line 52 to Col. 8, line 4.

Concerning Claim 9, see the discussion of Claim 1 above and *Korhammer* further discloses records reflecting orders for securities at Figs. 4 and 5.

With respect to Claim 10, *Korhammer* discloses bi-directional transfer of order information as bi-directional arrows among elements at Fig. 2.

With respect to Claims 11 and 12, see the discussions of the claims from which they depend and Claims 7 and 8 respectively.

With respect to Claim 13, *Korhammer* discloses order quantity as a filter at Col. 8, lines 28-38.

Concerning Claims 14 and 15, *Korhammer* discloses updating of order information at Fig. 6 and Col. 9, lines 26-49.

With respect to Claim 23, see the discussion of Claim 1 above.

With respect to Claim 24, see the discussion of Claims 23 and *Fox* further discloses updating of ETM trades at Fig. 3, ele. 306.

With respect to Claims 25 and 26, see the discussion of Claim 7 above.

With respect to Claim 27, see the discussions of Claims 8 and 23 above.

With respect to Claim 28, see the discussion of Claims 27 and 13 above.

With respect to Claim 29, see the discussion of Claim 23 and 14 above.

With respect to Claim 30, see the discussion of Claims 29 and 15 above.

As to Claims 31-37, they are the computer-readable medium form of Claims 9-15 and are rejected in a like manner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 6, and 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Korhammer* in view of *Bigus et al.*

With respect to Claim 3, *Korhammer* discloses the invention substantially as claimed. See the discussion of Claim 2 above. *Korhammer* does not specifically disclose a negotiating module for securities trading. *Bigus* discloses this feature at Summary of the Invention and Col.

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6, lines 12-24. Problems solved by a combination of the two references are set forth by *Bigus* at Col. 3, lines 31-42 regarding securities trading and reproduced below:

In addition, intelligent agents in electronic commerce applications must often be capable of determining a reasonable or acceptable value for a desired transaction. In many markets, especially those that are electronically controlled, market conditions can change rapidly. Stock, bond and commodity prices for example change continuously, and an agent which works with outdated information may enter into transactions that are well outside of the current market conditions at the time of the transactions. Moreover, some markets may be subject to manipulation by other parties attempting to obtain competitive advantages.

With respect to Claim 6, *Bigus* discloses a transaction history module at Fig. 1, ele. 82.

With respect to Claim 16, see the discussion of Claims 1 and 3 above and *Fox* further discloses a data integration module at Fig. 3, ele. 203 and Col. 7, lines 35-56.

Concerning Claim 17, provision of a plurality of resources would be obvious because this would have made the system available to more users. Additionally, throughput of the OIMs would be faster if each OMS had a dedicated OIM. This is essential in securities trading where time is of the essence.

With respect to Claim 18, ~~*Fox*~~^{*K*} discloses an ETM indications module for transmitting orders to other traders (keyboard) who also use an EIM module (display). By definition, a module is a self-contained component that can provide a complete function to a system and can be interchanged with other modules that provide similar functions.

With respect to Claim 19, see the discussion of Claims 18 and 8 above.

With respect to Claim 20, see the discussion of Claims 16 and 4 above.

With respect to Claim 21, see the discussion of Claims 16 and 5 above.

With respect to Claim 22, see the discussion of Claims 16 and 3 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R Kyle whose telephone number is (703) 305-4458. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


CRK

December 3, 2002


VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
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